

REMARKS

By this Reply, Applicants propose to amend claims 1, 12, 25, 35, 41, 44, and 45.

Claims 1, 5-8, 10-12, 16-22, 25, 29, and 35-45 are pending in this application.

In the Office Action¹, the Examiner:

rejected claims 1, 5-8, 10, 11, 25, 28, 29, and 35-38 under 35 U.S.C. § 101 as allegedly being drawn to non-statutory subject matter; and

rejected claims 1, 5-8, 10-12, 16-22, 25, 29, and 35-45 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,832,484 to Sankaran et al. ("Sankaran") in view of U.S. Patent No. 6,901,401 to Bangel et al. ("Bangel") and further in view of U.S. Patent 6,438,562 to Gupta et al. ("Gupta").

I. REJECTION OF CLAIMS 1, 5-8, 10, 11, 25, 28, 29, AND 35-38 UNDER § 101

Applicants respectfully traverse the rejection of claims 1, 5-8, 10, 11, 25, 28, 29, and 35-38 under 35 U.S.C. § 101 as allegedly being drawn to non-statutory subject matter. The Examiner alleges that the claims do not produce "useful, concrete and tangible results." See Office Action at page 2. Although Applicants disagree, Applicants have amended independent claims 1, 25, and 35 to recite methods that are "implemented on a computer-readable medium." Applicants submit the amended claims clearly recite statutory subject matter. Claims 5-8, 10, 11, 28, 29, and 36-38 depend from claims 1, 25, and 35, and accordingly are also clearly statutory. Therefore, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 101.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

II. REJECTION OF CLAIMS UNDER § 103(a)

Applicants respectfully traverse the rejection of claims 1, 5-8, 10-12, 16-22, 25, 29, and 35-45 under 35 U.S.C. § 103(a) as being unpatentable over Sankaran in view of Bangel and Gupta. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. *See* M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. *See id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the

prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Amended independent claim 1 recites a method for authorizing access to a database including "determining, by examining an employee number associated with the set of database records submitted in the new query, whether a user that submitted the new query is authorized to access the set of database records." Sankaran, Bangel, and Gupta, taken individually or in combination, do not disclose or suggest at least these claimed features.

Bangel discloses that a "determination is made as to whether the individual's user name was found as having special permission to access a local copy of the database" (emphasis added). See col. 4, lines 46-49. Bangel also discloses that "[o]n the other hand, if the user's user name was not found ... the user is denied access to the local copy of the database." See col. 4, lines 57 to col. 5, lines 4 (emphasis added). That is, in Bangel, a determination is made as to whether a user has access to a local copy of the database, rather than whether a user has access to a particular "set of database records," as recited in claim 1. Therefore, Bangel does not disclose or suggest at least "determining, by examining an employee number associated with the set of database records submitted in the new query, whether a user that submitted the new query is authorized to access the set of database records" (emphasis added), as recited in claim 1.

Sankaran and Gupta also do not disclose or suggest these features. The Office Action alleges that Sankaran discloses "detecting, by a computer, a new query for a set of database records ... [and] ... set[ting] the new lock [or] attempting to set the new lock

if the user is authorized,” and that Gupta discloses the claimed employee number.” (Office Action, pp. 4-5). Even if these allegations are correct, which Applicants do not concede, Sankaran and Gupta still do not disclose or suggest “determining, by examining an employee number associated with the set of database records submitted in the new query, whether a user that submitted the new query is authorized to access the set of database records,” as recited in claim 1. Therefore, Sankaran, Bangel, and Gupta, taken individually or in combination, do not teach or suggest all of the elements of claim 1.

In view of the above, the Office Action has not properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in view of the references. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1 and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Independent claims 12, 25, 35, 41, 44, and 45, although of a different scope from claim 1 and each other, include similar recitations as claim 1. Accordingly, a *prima facie* case of obviousness has not been established for the independent claims for at least the reasons discussed above in connection with claim 1. Claims 5-8, 10, 11, 16-22, 29, 36-40, 42, and 43 depend from the independent claims. Accordingly, a *prima facie* case of obviousness has not been established for the claims at least due to their dependence. Therefore, the Examiner should also withdraw the rejection of the dependent claims under 35 U.S.C. § 103(a).

CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing the claims in condition for allowance. Applicants submit that the proposed amendments of the claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

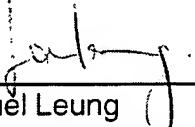
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Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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